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Supreme Court of the United States

October Term, 1955

No. 149

CARLSON & SULLIVAN, INC.,

Petitioner,

v.

BIGELOW & HOWES COMPANY

and

THE STANLEY WORKS,

Respondents.

PETITION FOR REVIEW ON WRIT OF CERTIORARI
TO THE
UNITED STATES COURT OF APPEALS
FOR THE [illegible] CIRCUIT

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PETITION FOR REVIEW ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner Carlson & Sullivan, Inc., respectfully submits this its petition for a writ of certiorari directed to the United States Court of Appeals for the First Circuit to enable this Court to review judgments entered by said court in a patent infringement action entitled Carlson & Sullivan, Inc., Plaintiff-Appellant, v. Bigelow & Dowse Co. and The Stanley Works, Defendants-Appellees.

The opinion of the court of appeals affirming the judgment of the district court adjudging invalid certain of the patent claims admittedly infringed by respondents was filed on March 19, 1953 and is reported in 202 F.2d 654.

A petition for rehearing was filed April 3, 1953 and was denied April 9, 1953 without opinion.

The judgment of the district court from which appeal was taken was entered on April 4, 1952 on an opinion filed April 3, 1952 and reported in 105 F. Supp. 531.

Jurisdiction

Jurisdiction is invoked under 28 U.S.C. § 1245(1) and 28 U.S.C. § 2101(c).

Summary

Petitioner's action charged infringement of certain claims of its United States Letters Patent 2,510,939 to Carlson for improvements in a ruler construction wherein a steel measuring blade is extensible from and retractable into a case. Respondents, in defense, pleaded and urged invalidity of these claims in view of pleaded prior art patents and prior uses allegedly disclosing the same invention and on the ground that the claims are invalid as expressing no patentable invention over the prior art.

At the trial respondents openly admitted infringement of claims 10, 13, 14 and 17, if valid.

To sustain both defenses, respondents offered in evidence nothing more than certain of the pleaded prior art patents and prior uses.

The trial court found, as a fact, that the prior art and the alleged prior uses did not disclose the claimed invention and that, therefore, there was no anticipation thereof. It also found the invention to be an advance over the prior art which "certainly must be described as an improvement in the art" (R. 16) and which solved a problem existent in the art (R. 17).

No testimony was offered to overcome the presumption of validity by proof that these improvements were devoid of patentable invention by any test. Nevertheless, the trial court, brushing aside the presumption of validity, ruled the claims invalid merely on its view unsupported by evidence that the improvements were not "startling or revolutionary".

This manifest error of the district court in not following the rules of evidence and in disregarding the validity

presumption without proof that the improvement would have been obvious to a person having ordinary skill in the art has been erroneously perpetuated by the court of appeals in affirming the district court's decision. This error formed the basis for the petition for rehearing before the court of appeals; the denial of the petition indicates that the court of appeals believes it has power to overcome a presumption not by the judicial function of weighing evidence but purely by *a priori* subjective reasoning.

Question Presented

Where there is no testimony whatsoever that a patented improvement, found by a court to be novel and "an improvement in the art", would have been obvious to a person having ordinary skill in the art at the time the invention was made, does that court have power to disregard the presumption of validity of the patent and rule the improvement to be unpatentable merely on its own view that said improvement is not "startling or revolutionary"? This Court in *Keyes and ano.* v. *Grant and ano.*, 118 U.S. 25, (1886) has said that the issue of patentability of an invention constituting an improvement over the prior art must be determined on evidence directed thereto and not as a matter of mere opinion of the court. Accord, *Smith* v. *Goodyear Dental Vulcanite Co. et al.*, 93 U.S. 486 (1876); *Lehnbueter* v. *Holthaus*, 105 U. S. 94 (1881); *Cantrell et al.* v. *Wallick*, 117 U.S. 689 (1886).

Reason for the Allowance of the Writ

The granting of this petition will afford this Court an opportunity to instruct the lower courts that, in orderly judicial procedure, presumptions may be overcome only by evidence; and that they have no power to invalidate claims on a patented improvement invention where there is no evidence that the improvement would have been obvious to a person having ordinary skill in the art at the time the invention was made.

BRIEF

Respondents alleged and attempted to prove that the invention of the patent in suit was anticipated by the prior art. They also alleged and urged, but offered no proof, that the claims of the patent in suit are invalid because the invention defined therein would have been obvious at the time it was made to a person having ordinary skill in the art.

The trial court held, however, that the claimed invention was not disclosed in the prior art and, therefore, was not anticipated. Thus, the patented invention is in the class of improvement inventions whose patentability has long been tested by rules laid down from time to time by this Court. The classic test, now statutory (35 U.S.C. § 103), has been and is whether or not the improvement would have been obvious at the time the invention was made to a person having ordinary skill in the art.

The testimony established and the trial court found that the claimed invention is an improvement which solved a then-existing problem that others, including respondent The Stanley Works, had attempted but failed to solve (R. 304, 305, 337); that the appearance of the patented ruler on the market created a new branch of the steel tape ruler industry (R. 98); and the patented ruler was so commercially successful that respondent The Stanley Works, in order to meet petitioner's competition, found it necessary to market a ruler different from any of the types that it had earlier designed (R. 95, 249, 258, 261). The Stanley Works has conceded that this different ruler employs the invention claimed in and infringes claims 10, 13, 14 and 17 of the patent in suit, if valid.

Nevertheless, without any testimony tending to show that the improvement would have been obvious to one having ordinary skill in the art at the time the invention was made, and without a finding to that effect, the trial court substituted its subjective opinion for evidence and ruled the claims invalid on the sole ground that the invention

was not "startling or revolutionary". In so doing, the court clearly violated the long recognized rule of evidence that a presumption can be overcome only by evidence.

Petitioner contends that the trial court had no right to rule the patent invalid merely because in its subjective opinion the invention was not "startling or revolutionary"; the court should have ruled that the presumption of validity had not been overcome by evidence.

The court of appeals, in sustaining the district court, committed the same error and so erroneously condoned that of the trial court, thus, also disregarding the rule laid down by this Court in *Keyes and ano.* v. *Grant and ano., supra.*

In the *Keyes* case there was conflicting testimony on the issue of whether invention or mere mechanical skill was involved. The trial court withdrew the case from the jury and directed a verdict for defendant, thus substituting its opinion on this point for a verdict of the jury. The Supreme Court ruled this to be error and remanded. If it was error for the trial court to decide the issue when there was some testimony that the advance over the art was only that which would be expected from one skilled in the art, it is certainly error so to decide when the record contains no evidence at all, as in the instant case, on the issue. In reversing the lower court the Supreme Court said:

> "So that it certainly was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result, or, if material at all were only such as would not require the exercise of the faculty of invention, but would be suggested by the skill of an experienced workman employed to produce the best results in the application of the well known arrangements of the furnace."

In *Radio Corporation of America et al.* v. *Radio Engineering Laboratories, Inc.*, 293 U.S. 1 (1934), the Supreme Court affirmed this rule stating:

> "Even for the purpose of a controversy with strangers, there is a presumption of validity, a presumption not to be overthrown except by clear and cogent evidence.
>
> • • • • •
>
> "Through all the verbal variances, however, there runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance."

A case typifying the application of the rule as here urged by petitioner is *Huston* v. *Barrett*, 23 F.2d 907 (5th Cir. 1928), involving a patent for a bag of salted peanuts. As stated by the circuit judge, the patent claimed:

> "a long, narrow bag, made of ribbed transparent paper, the ribs being arranged lengthwise of the bag, the length of the bag being greater than the width of a man's hand, long enough to permit both ends to project substantially from the hand grasping it, the width being narrow enough for insertion into the mouth, the closed end of the bag being formed and sealed flat, and the other end being also flat and capable of being securely closed by a gummed flap."

The trial court had granted a motion to dismiss based upon lack of invention. The court of appeals reversed, holding:

> "We do not judicially know that the type of paper bag called for by the patent does not possess any of the advantages or useful capabilities claimed for it. This being so, the presumption of invention created by the grant of the patent prevails until it is rebutted or overcome by evidence."

For subsequent litigation sustaining the same patent see *O. K. Jelks & Sons* v. *Tom Huston Peanut Co.*, 52 F.2d 4 (5th Cir. 1931), certiorari denied, 284 U.S. 686.

Petitioner submits that the *Keyes* case, the *Radio Corporation* case, and now the Patent Act of 1952 (35 U.S.C.

§ 103) correctly and consistently state the rule of law. The *"Peanut Bag"* case shows a proper application of it. The rule undoubtedly is applicable to and dispository of the present case since all of the parties to the action here are in agreement that *no* testimony was offered which, if believed, would tend to show that the patented improvement would have been obvious at *any* time to *any* sort of person (Brief for Defendants-Appellees before the court of appeals, p. 3, footnote).

If the law has not been changed, the petition here sought should be granted and the decision appealed from should be reversed; or the case should be returned to the trial court with directions to take evidence, if there is any, that the claimed invention would have been, at the time the invention was made, obvious to a person having ordinary skill in the art.

If the law has been changed, the petition here sought should be granted and the view of this Court set forth so that the patent bar and those whose businesses depend upon the enforceability of patents may know their true positions.

Respectfully submitted,

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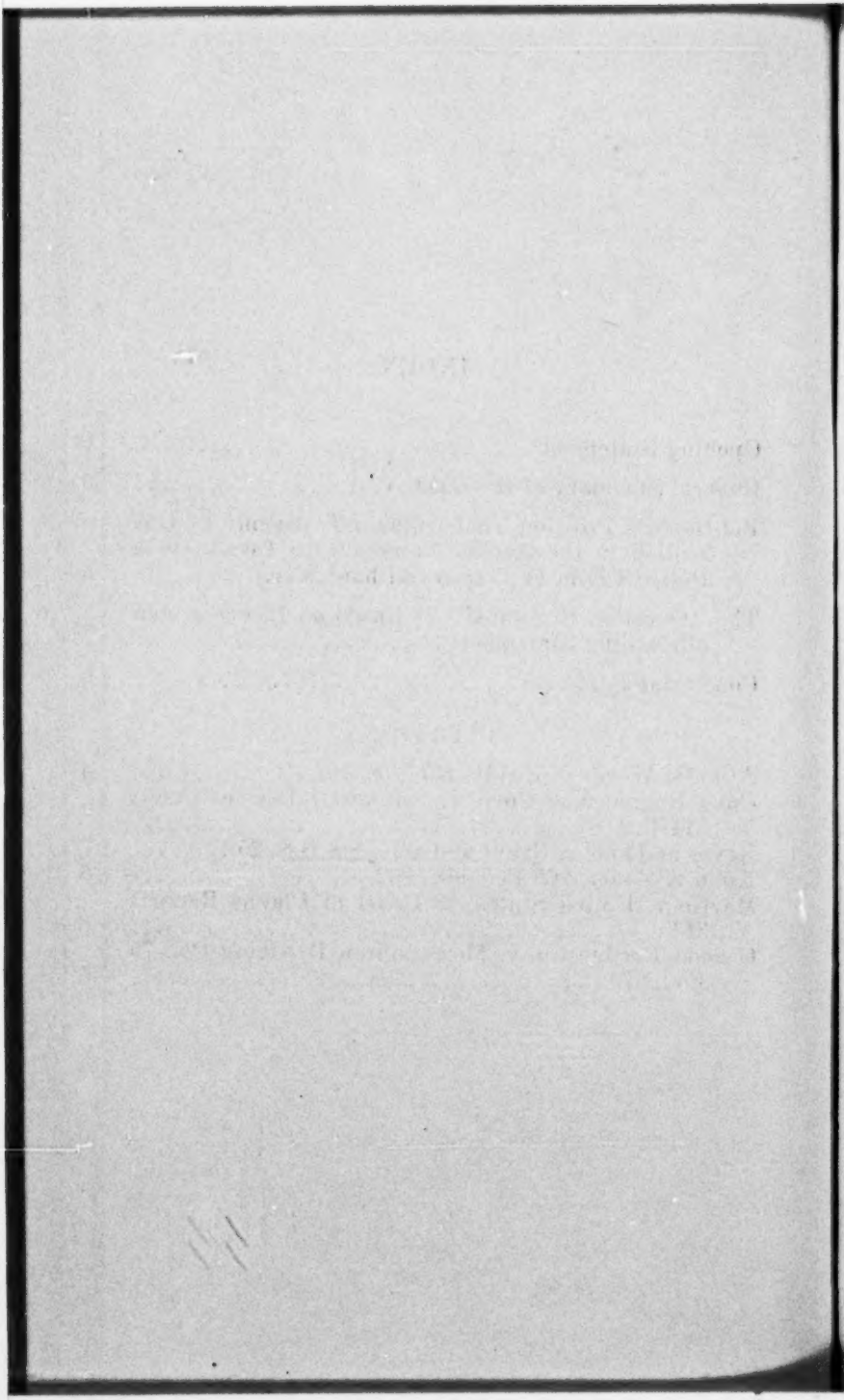

IN THE

Supreme Court of the United States

OCTOBER TERM, 1953

No. 149

CARLSON & SULLIVAN, INC., *Petitioner*

vs.

BIGELOW & DOWSE COMPANY and THE STANLEY WORKS, *Respondents.*

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is an ordinary patent case merely involving the question of patentability of certain claims of the Carlson patent No. 2,510,939 relating to a coilable measuring rule of an old and well-known character.

As we understand it, the Petition for Writ of Certiorari is based on the contention, inter alia, that it has long been and now is the established rule of law that no court can declare a patent claim invalid for lack of invention in the absence of opinion testimony by one skilled in the art that the improvement, as of the time that the alleged invention was made, would have been obvious to a person having ordinary skill in the art. The contention is without merit.

There is no conflict of opinion between Courts of Appeals, no unsettled legal proposition, and no question of general or public interest.

GENERAL SUMMARY OF THE CASE

This action was based on four groups of claims contained in the Carlson patent in suit. Petitioner in the Courts below maintained that each group covered a distinct and separate invention. The Courts ruled adversely against all of the twelve claims relied upon.

The Petition for a Writ of Certiorari is very confusing and ambiguous but, as we understand it, the Petition asks for a review of the opinion of the Court of Appeals for the First Circuit only as to the second group of claims, namely claims 10, 13, 14, and 17.

These claims are generally directed to coilable rules of the push-pull type having a case, a wind-up spring, and a concavo-convex steel blade adapted to be drawn into the case by the spring. Rules of this type were admittedly old and well-known long before the patent in suit. These claims are particularly concerned with the feature of making the spring long enough or so adjusting it that the end thereof may extend outside of the case for the purpose of ready access when it is desired to replace an old blade with a new one. The subject matter of these four claims is outlined by the District Court on page 15 of the Record and is discussed by the Court of Appeals starting on Record page 643.

The petitioner before the District Court largely based its case on the contention that what Carlson had done over the prior art was "startling or revolutionary" and was the result of a "flash of genius". The District Court in its opinion rejected this contention. It held (R. p. 17):

> "To summarize, Carlson's rule is not a radically different one. The improvement which he made does not amount to such an innovation as to warrant a finding of invention. He solved a problem—that of constructing a rule so that the blade could be replaced outside the casing, but this was not startling or revolutionary, especially when one considers that although the springs in prior art rules were not normally adjusted so that their free ends could be

withdrawn from the casings, they could be so adjusted simply by assembling the parts with two fewer turns in the wind-up spring."

The District Court may also have had in mind the proofs that these coilable rules sell for about $1.00 each and a replacement blade for about fifty cents, and that the average person having one of these rules would make a blade replacement only once in about every twenty years, and a skilled workman somewhat more frequently.

The petitioner here has the temerity to criticize the District Court for not considering the petitioner's present contention concerning the necessity, for a finding of invalidity, of opinion testimony in the record by one skilled in the art that no invention was involved. This criticism is most unjust and unfair! The contention was not advanced or urged to the slightest degree by the petitioner at trial, in its Main Brief, its Reply Brief, nor in its Proposed Findings filed with the District Court. We submit that the petitioner is remiss for lack of forthrightness in not bringing this fact to the attention of this Honorable Court.

Before the Court of Appeals, petitioner completely abandoned and disclaimed its contention that what Carlson had done was "startling or revolutionary,"—"a flash of genius". Instead, for the first time in this action, the petitioner contended that Section 103 of the new Patent Act, which became effective January 1, 1953, had changed and, in effect, reversed the "severe test" that, to warrant a finding of invention, the advance must be a "radical innovation" and "startling" or "revolutionary" and which "severe test" was alleged by petitioner to have been set up by this Honorable Court at least as early as 1941 (citing *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84). Petitioner, for the first time, before the Court of Appeals contended that the new Patent Act lowered the requirements for patentability to what they had been before and, further urged, for the first time,

that under the new Patent Act no court could hold a patent claim invalid unless there was opinion testimony by one skilled in the art that the advance would have been obvious at the time the invention was made to a person skilled in the art. (Petitioner here before this Honorable Court makes no contention that the new Act changed the standard of patentability in any way; on the other hand, it urges that the standard of invention required to sustain a patent claim has long been and still is the same.)

Referring now to the decision of the Court of Appeals which starts on page 639 of the Record:

(a) The Court of Appeals held that petitioner's contention that the new Act had lowered the standard of invention was not tenable and, in any event, the new Act did not apply to the present case. (Petitioner here accepts those conclusions for it raises no question with respect thereto in its Petition for Certiorari.)

(b) With respect to the test for patentable invention applied by the District Court, the Court of Appeals said (R. p. 643):

> "The appellant [petitioner] cannot successfully attack the above finding of invalidity on the ground that the District Court too strictly applied the test for patentable invention. It is the law, at least it has been the law since Atlantic Works v. Brady, 107 U.S. 192, was decided in 1882, that the purpose of the patent laws 'is to reward those who make some substantial discovery or invention,' not 'to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures.' 107 U.S. at 200. Clearly this traditional test is the one the court below applied when it said that the patentee's improvement in the art did not amount to a substantial enough innovation to amount to invention. And we are convinced by a study of the record

and the exhibits that this finding is fully supported by the evidence. * * *"

* * * * * * *

"The second group of claims [10, 13, 14, 17] covering extensibility of the spring outside the case, and a hole therein for insertion of a pin to prevent the spring from accidentally snapping back into the case during the operation of changing an old blade for a new one, falls by application of the same test"

(c) The Court of Appeals refused to find that Carlson made an improvement in the art. As to one of Carlson's alleged novel features, the Court said that so far as it could tell "the Carlson ruler shows little, if any, improvement in this respect over the rules of the prior art". Relative to the feature of making the return spring long enough to extend outside of the case for the purpose of ready access to the coupling for joining it to a new blade (Claims 10, 13, 14 and 17) the Court of Appeals indicated there was little, if any, improvement over the prior art, by saying:

"Assuming that there is both utility and novelty, instead of sales appeal, in a push-pull rule so constructed * * * it is certainly not more than one would expect from a person skilled in the art."

PETITIONER'S POSITION THAT OPINION TESTIMONY BY ONE SKILLED IN THE ART IS NECESSARY TO INVALIDATE A PATENT CLAIM IS TOTALLY WITHOUT MERIT

The Courts, since as early as 1850, have uniformly exercised their own judicial opinions, without benefit or consideration of opinions of experts or those skilled in the art, in finding and concluding that the differences between the claimed invention and the prior art amounted to no more than what could be expected of the "man skilled in the art".

We have looked in vain for a decision which would support petitioner's position. In fact, after diligent

search we find no decided case in which the question here presented was raised, except, possibly in a simple decision, wherein the Court of Claims said in 1939:

> "There is, as plaintiff contends, no direct testimony that this involved only mechanical skill. No witness testified to that effect but the evidence as a whole makes this conclusion so manifest that direct testimony by an expert is not required in order to enable the court to reach the conclusion set out in the findings."
>
> *Martin* v. *United States,* 88 Court of Claims Reports 314.

We do find decisions,—and many of them,—which spurn and reject opinions of experts on the question of patentability.

The Court of Appeals for the First Circuit said in 1896:

> "In these expressions the expert, as is too common in the taking of evidence of that class, goes beyond the province of an expert, and into the province of counsel or the court. Whether or not the article to which he refers was 'a new article of manufacture', in any substantial sense which has relation to the subject-matter of patents, is a mixed question of law and fact, with which the expert has no concern. To admit his propositions in this behalf would be to admit the entire case and *'take it wholly from the court'.*"
>
> *Osgood Dredge Co.* v. *Metropolitan Dredging Co.,* 75 Fed. 670:

Judge Learned Hand in 1920 said:

> "When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is inevitably a burdensome impertinence."
>
> *Kohn* v. *Eimer,* 265 Fed. 900, 902.

Certainly, none of the decisons referred to in the Petition for Certiorari and supporting Brief even remotely supports petitioner's contention. It is interesting to note

that the latest decision referred to in the Petition was rendered by this Court in 1886 and yet petitioner would have it that it has always been the rule of law that opinions by "skilled-in-the-art" witnesses are necessary in the record to defeat a patent.

This Court's decision in *Keyes and ano.* vs. *Grant and ano.*, 118 U.S. 25, and on which petitioner principally relies, is entirely irrelevant. That was a patent case tried to a jury. There the Court did not submit to the jury the question of patentability under suitable instructions but, on the other hand, took the question away from the jury by instructing it to find a verdict for the defendant. This Court found this was error and remanded the case. The instant action was not and is not a jury case. This action was tried entirely by the Court.

The other cases cited by petitioner are obviously so irrelevant that it would be a waste of time to discuss them here.

THE "QUESTION PRESENTED" IS BASED ON INCORRECT AND MISLEADING STATEMENTS

The "Question Presented" (page 3 of the Petition for Certiorari) is inaccurate and misleading in that it contains assumptions and assertions which are contrary to fact.

First, the question implies that there is no testimony whatsoever on which to base a finding that the alleged improvement was obvious to a person having ordinary skill in the art at the time the invention was made. The Record establishes the trial took four days and respondents put in full proofs in support of the defenses of lack of invention and anticipation. Further, there was evidence that those skilled in the art were of the opinion that there was no invention, that evidence being that all rule manufacturers of this type are defying Claims 10, 13, 14 and 17 of the patent.

Second, the question implies that the Court of Appeals found that Claims 10, 13, 14 and 17 were directed to a novel

improvement in the art. That is contrary to fact. That Court, as we have pointed out, questioned whether there was any improvement over the prior art and merely *assumed,* for purpose of discussion—

> "that there is both utility and novelty, instead of mere sales appeal".

Third, the "Question Presented" asserts, in effect, that the Court of Appeals disregarded "the presumption of validity of the patent". The Court had before it prior art structures, prior art patents, and proofs with respect thereto which clearly overcame the presumption of validity. Much of this prior art was not cited by the Patent Office. The Court found that the claims were invalid for lack of invention principally in light of the prior art Stanley and Master commercial rules and the proofs with respect thereto, none of which were in any way referred to in the file wrapper of the Carlson patent. The Court had this file wrapper before it (Exh. Z, R. p. 423).

Fourth, the "Question Presented" would have it that the Court of Appeals found unpatentability "merely on its own view that said improvement is not 'startling or revolutionary' ". That is not true, as we have pointed out, supra. The Court specifically refused to adopt that strict standard for invention and it found that the District Court had not done so.

CONCLUSION

We submit that the Petition is wholly without merit and should be denied.

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